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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,864	12/11/2001	Michael J. Tari	ICOR-004	3644

26137 7590 08/06/2008

PATENT DEPARTMENT
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
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NEW YORK, NY 10036

EXAMINER

GREIMEL, JOCELYN

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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08/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/014,864	Applicant(s) TARI ET AL.	
	Examiner JOCELYN GREIMEL	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is in response to Applicant's Amendments and Remarks filed 25 April 2008.

Status of Claims

Claims 1-14 are currently pending. Claims 1, 8, 12 and 14 are independent claims.

Claims 5 and 8 are currently amended.

Response to Arguments

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over May (US Patent Pub. 2002/0116317) in view of Luke et al (US Patent No. 6,131,087, hereinafter Luke).

In reference to claims 1, 8 and 12-14, May discloses a method, system and apparatus for electronically trading financial instruments among a plurality of traders, each trader being associated with one or more sets of tradeable structures, comprising:

- a. receiving a request for proposal ("RFP") on a financial instrument from a requestor, the RFP including an RFP structure (209+);
- b. during a first response period, receiving two or more responses to said RFP from two or more responders, each said responder providing at least one said response; transmitting said two or more responses to said requestor; allowing said requestor to trade on said two or more responses during a first exclusivity period, each said plurality of traders not being allowed to trade on said two or more responses during said first exclusivity period unless each said trader

comprises said requestor, said first response period and said first exclusivity period being allowed to overlap (234+; 318-335); and

c. at the expiration of said first exclusivity period, allowing said two or more responders to trade on said responses during a second exclusivity period, said traders not being allowed to trade on said responses during said second exclusivity period unless each such trader comprises a requestor or said two or more responders (234-237; 318-335).

May does not disclose: "providing an alert to each trader whose tradeable structures include the RFP structure." However, Luke discloses: "providing an alert to each trader whose tradeable structures include the RFP structure" (col. 8-9). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the trading structure of May to include the alert of Luke as it would have been more efficient for the potential bidders, thereby making the system more efficient and user-friendly.

In reference to claim 2, May teaches the electronic trading method and system further comprising matching orders at the expiration of said first period and before allowing said responders to trade on said responses (234+). May discloses the above but does not disclose: "providing an alert to each trader whose tradeable structures include the RFP structure." However, Luke discloses: "providing an alert to each trader whose tradeable structures include the RFP structure" (col. 8-9). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the

trading structure of May to include the alert of Luke as it would have been more efficient for the potential bidders, thereby making the system more efficient and user-friendly.

In reference to claim 3, May discloses the electronic trading method and system wherein said orders are associated with a bid price or an offer price, said matching orders process further comprising matching crossed orders in which the highest bid prices is higher than the lowest offer price (matching 209-237; 318+). May does not disclose: "providing an alert to each trader whose tradeable structures include the RFP structure." However, Luke discloses: "providing an alert to each trader whose tradeable structures include the RFP structure" (col. 8-9). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the trading structure of May to include the alert of Luke as it would have been more efficient for the potential bidders, thereby making the system more efficient and user-friendly.

In reference to claim 4, May discloses the electronic trading method and system wherein any responses, which have not been traded on at the end of, said second period are migrated to a general market (209-237; 318+). May does not disclose: "providing an alert to each trader whose tradeable structures include the RFP structure." However, Luke discloses: "providing an alert to each trader whose tradeable structures include the RFP structure" (col. 8-9). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the trading structure

of May to include the alert of Luke as it would have been more efficient for the potential bidders, thereby making the system more efficient and user-friendly.

In reference to claim 5, May discloses the electronic trading method and system wherein traders are grouped into trading groups, said method further comprising transmitting said at least one response to said requestor's trading group and said at least one responder's trading group, each said plurality of traders not receiving said two or more responses unless said trader comprises a trader in said requestor's trading group or said at least one responder's trading group (matching 209-237; bilateral credit 318-331). May does not disclose: "providing an alert to each trader whose tradeable structures include the RFP structure." However, Luke discloses: "providing an alert to each trader whose tradeable structures include the RFP structure" (col. 8-9). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the trading structure of May to include the alert of Luke as it would have been more efficient for the potential bidders, thereby making the system more efficient and user-friendly.

2. In reference to claims 6-7, 9 and 11, May discloses the electronic trading system, method and apparatus, including:

- a. allowing trader's in said requestor's trading group to trade on said responses during said first period, each said plurality of traders not being allowed

to trade on said response during said first period unless said trader comprises a trader in said requestor's trading group;

b. allowing traders in said responder's trading group to trade on said responses during said second period;

c. wherein said tradable structures for each said trader are a function of potential traders to a trade;

d. migrating said responses to a general market at the expiration of said third exclusive period (318-335).

May does not disclose: "providing an alert to each trader whose tradeable structures include the RFP structure." However, Luke discloses: "providing an alert to each trader whose tradeable structures include the RFP structure" (col. 8-9). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the trading structure of May to include the alert of Luke as it would have been more efficient for the potential bidders, thereby making the system more efficient and user-friendly.

In reference to claim 10, May discloses the electronic trading method and system wherein said first period and said second period are co- terminus (209-237; 318+). May does not disclose: "providing an alert to each trader whose tradeable structures include the RFP structure." However, Luke discloses: "providing an alert to each trader whose tradeable structures include the RFP structure" (col. 8-9). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified

the trading structure of May to include the alert of Luke as it would have been more efficient for the potential bidders, thereby making the system more efficient and user-friendly.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached on Monday - Friday 8:30 AM - 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from

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a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
July 31, 2008

/Stefanos Karmis/

Primary Examiner, Art Unit 3693